

REMARKS

The above amendments and following remarks are submitted within the 60 day priority period under 37 C.F.R. 1.116 in response to the pending Final Official Action of the Examiner mailed May 1, 2007. Having addressed all objections and grounds of rejection, claims 1-21, being all the pending claims, are now deemed in condition for allowance. Entry of this amendment and reconsideration to that end is respectfully requested.

Claims 1, 3, 8, 10, and 13-15 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting in view of co-pending U.S. Patent Application Serial No. 10/849,473 (hereinafter called "Vanyo"). It seems clear that this provisional rejection is improper on its face at least as to claims 3, 8, 10, and 13-15, because these claims depend from claims which have been found patentably distinct from Vanyo (e.g., claims 2, 6-7, 9, and 11-12). Nevertheless, Applicants acknowledge this provisional rejection and will address the matter upon allowance of all pending claims.

Claims 1-21 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,240,417, issued to Eastwick et al. (hereinafter referred to as "Eastwick"). This ground of rejection is respectfully traversed for the following reasons.

The standards for a finding of anticipation during examination are specified in MPEP 2131, which provides in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH  
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

The rejection is respectfully traversed because "the identical invention" is not shown by Eastwick "in as complete detail as is contained in the claims" as is required by MPEP 2131.

The present invention provides a technique for utilizing a user terminal coupled via a publicly accessible network (e.g., the world wide web) to a legacy data base via a legacy data base management system wherein said legacy data base contains a "stored procedure" and said legacy data base management system executes the "stored procedure" in response to a request by the Internet terminal. All claims are limited to the claimed "stored procedure" being "executed by" and/or "stored within" the claimed legacy data base management system. Though Applicants' claims have differing limitations and scopes, each is based upon the key feature of a "stored procedure", located in the legacy data base and/or executed by the legacy data base management system in

response to a request by the user terminal coupled via a publicly accessible network.

Eastwick, on the hand, does not have the disclosed and claimed "stored procedure". Therefore, the Examiner has attempted to read this limitation onto "database integrator" 314 disclosed by Eastwick. The "database integrator" 314 of Eastwick is readily distinguishable from Applicants' "stored procedure" in that the "database integrator" 314 is located within memory 302 of workstation 102 (see Fig. 3 and corresponding description at column 4, lines 23-29), rather than in the legacy data base. As a result, "database integrator" 314 is executed by workstation 102 rather than by a legacy data base management system. Thus, the "database integrator" 314 is not coupled to workstation 102 by a network, but is coupled through an internal memory bus.

Applicants have previously made this argument to the Examiner. In her response thereto, the Examiner appears to agree with Applicants concerning the preferred embodiments disclosed by Eastwick. Therefore, she confusingly cites column 3, lines 52-62 of Eastwick which mentions a non-disclosed and apparently non-preferred embodiment wherein the "client program" (i.e., containing the "database integrator" 314) and legacy DBMS are co-located "on the same computer". This response is confusing, because the Examiner does not explain how the "client program" and "legacy DBMS" could possibly be coupled via the claimed

publicly accessible digital data communication network, if they are co-located "on the same computer".

In her apparent vigor to find Applicants' claimed invention within Eastwick, the Examiner continues to ignore the specifically claimed requirement that the claimed "stored procedure" must be located within and executed by the claimed legacy data base management system. Eastwick, on the other hand, requires the "database integrator 314" to be co-located within and executed by the workstation 102.

The differences between Eastwick and Applicants' claimed invention are readily apparent in structure and operation. These differences become even more apparent as the individual claim limitations are considered.

Claim 1, for example, has four basic elements. The first element is "a user terminal which generates a user request". In making her rejection, the Examiner cites workstation 102 of Eastwick. Though Eastwick does not explicitly mention the claimed "user request", apparently the Examiner finds this element to be inherent. However, in doing so, she has failed to comply with MPEP 2112.

The second claimed element is "a publicly accessible digital data communication network responsively coupled to said user terminal". In making her rejection, the Examiner cites Eastwick as stating: "any communication connection". Applicants do not

understand the extent of this citation. The only actual examples provided by Eastwick at column 4, lines 2-3 (i.e., "direct connection", "local area network", and "wide area network"), do not meet the limitations of Applicants' claimed invention. As a matter of law (see MPEP 2131), to anticipated Applicants' claimed invention, the network of Eastwick "must be shown in as complete detail as is contained in the ... claim". Surely, the Examiner does not contend the Eastwick meets this requirement. Therefore, it Eastwick clearly does not show the "exact invention in as complete detail as is contained in the claim" as specifically required by MPEP 2131.

The third claimed element is "a legacy data base management system having access to at least one data base responsively coupled to said user terminal via said publicly accessible digital data communication network". Without addressing the Examiner's findings in detail with regard to this claimed element, it is clear that Eastwick cannot meet this limitation, because it does not have the claimed "publicly accessible" coupling network.

The fourth claimed element is "a stored procedure having a sequence of command script statements responsively coupled to said legacy data base management system which is executed by said legacy data base management system in response to said user request". As explained above, this limitation cannot be met by

"database integrator" 314 of Eastwick, as alleged by the Examiner, because it is not executed or executable by the legacy data base management system.

Therefore, the Examiner has simply ignored this claim limitation in contravention of controlling law. As a result, the Examiner's finding with regard to this element is legally irrelevant, because it does not address Applicants' claimed invention.

As a result of Eastwick not having the four claimed elements of claim 1, the rejection of claim 1, and all claims depending therefrom, is respectfully traversed.

Claim 2 depends from claim 1 and is further limited by "wherein said user terminal generates a second user request which causes said legacy data base management system to add parameters to said stored procedure". Again, the Examiner cites operational details of workstation 102 having nothing to do with the claimed causing "said legacy data base management system to add parameters to said stored procedure". The rejection of claim 2 is respectfully traversed for failure of Eastwick to meet the requirements of MPEP 2131 to show anticipation.

Claim 3 depends from claim 2 and further limits the claimed legacy data base. As explained above, Eastwick cannot meet the limitations of claim 2 from which claim 3 depends. Therefore,

Eastwick cannot have the further limitations of claim 3. The rejection of claim 3 is respectfully traversed.

Claim 4 depends from claim 3 and further limits the claimed legacy data base. As explained above, Eastwick cannot meet the limitations of claim 3 from which claim 4 depends. Therefore, Eastwick cannot have the further limitations of claim 4. The rejection of claim 4 is respectfully traversed.

Claim 5 depends from claim 4 and further limits the claimed data base management system. Because the Examiner realizes that Eastwick cannot meet this limitation, she irrelevantly states:

....whereas Eastwick's teachings of a software interface in conjunction with legacy data in a database reads on Applicant's claim language involving a BIS.

This finding is legally irrelevant, because it does not address Applicants' claimed invention. Furthermore, even if relevant, it is inadequate as a matter of law, because it does not show the "identical invention in as complete detail as is contained in the claim" as is explicitly required by MPEP 2131. The rejection of claim 5 is respectfully traversed.

Claim 6 is an independent method claim having four key steps. Claim 6 is "method of utilizing a user terminal to access a command language scripted **stored procedure within a legacy data base management system** having at least one data base". The claim requires that the claimed "stored procedure" be located "with a

legacy data base management system". Ignoring Applicants' claimed invention, the Examiner clearly erroneously finds:

Eastwick et al. teaches a. transmitting a service request requesting access to said command language scripted stored procedure....

The request (if any) is not "transmitted" as found by the Examiner, because the alleged "stored procedure" is located within workstation 102, as explained above.

The second claimed step requires "receiving said service request by said legacy data base management system". This step is not found in Eastwick, because the request (if any) must be modified by "database integrator" 314 before transfer from workstation 102. As a result, the claimed "request" is neither "transmitted" (i.e., step a) nor "received" (i.e., step b) as claimed, but is simply converted by "database integrator" 314 within workstation 102.

Because Eastwick does not meet all of the limitations of claim 6, the rejection of claim 6, and all claims depending therefrom, is respectfully traversed.

Claim 7 depends from claim 6 and requires execution of the claimed "stored procedure" by the claimed legacy data base management system. Eastwick cannot meet this limitation, because "database integrator" 314 is located within and executed by workstation 102. Therefore, the Examiner paraphrases Applicants' claim, omitting limitations clearly not found in Eastwick.

Therefore, her findings are legally irrelevant, because they do not address Applicants' claimed invention. The rejection of amended claim 7 is respectfully traversed.

Claim 8 depends from claim 7 and further limits the claimed coupling network to the "Internet". In making her rejection, the Examiner clearly erroneously states:

As for Claim 8, Eastwick et al teaches a publicly accessible digital data communication network further comprises the Internet (col. 3, lines 65-67 - col. 4, lines 1-3).

This statement is clearly erroneous, because Eastwick makes no mention of a "publicly accessible" network as claimed and certainly says nothing of the Internet. The rejection of claim 8 is respectfully traversed as based upon clearly erroneous findings of fact.

Claim 9 depends from claim 8 and is further limited by "further comprising transferring a second service request from said user terminal to said legacy data base management system which causes said accessing step to enter parameters into said command language scripted stored procedure". Again, the Examiner cites operational details of workstation 102 having nothing to do with the claimed causing "said accessing step to add parameters to said stored procedure". The rejection of claim 9 is respectfully traversed for failure of Eastwick to meet the requirements of MPEP 2131 to show anticipation.

Claim 10 depends from claim 9 and further limits the claimed data base management system. Because the Examiner realizes that Eastwick cannot meet this limitation, she refers to her rejection of claim 5 which irrelevantly states:

....whereas Eastwick's teachings of a software interface in conjunction with legacy data in a database reads on Applicant's claim language involving a BIS.

This finding is legally irrelevant, because it does not address Applicants' claimed invention. Furthermore, even if relevant, it is inadequate as a matter of law, because it does not show the "identical invention in as complete detail as is contained in the claim" as is explicitly required by MPEP 2131. The rejection of claim 10 is respectfully traversed.

Claim 11 is an independent apparatus claim having three "means-plus-function" limitations. The second element is "offering means responsively coupled to said permitting means via said publicly accessible digital data communication network for offering legacy data base management services involving access to at least one data base having a scripted command language stored procedure". It specifically requires that the claimed "stored procedure" be located within the claimed "data base" of the claimed "offering means". Therefore, the Examiner cites material (e.g., column 1, lines 56-59) supporting Applicants' position stating in part:

The application program ("client program") is located on a workstation....

Thus, DB Integrator 314 is located within workstation 102 (see Fig. 3).

Nevertheless, in finding the third claimed element, the Examiner completely ignores claim element b and again relies upon functions performed within workstation 102. As explained above, the claimed "stored procedure" is executed by the claimed "offering means". The rejection of claim 11, and all claims depending therefrom, is respectfully traversed.

Claim 12, as amended, depends from claim 11 and further limits the claimed "offering means". Eastwick cannot meet this limitation, because "database integrator" 314 is located within and executed by workstation 102. The rejection of claim 12 is respectfully traversed.

Claim 13 depends from claim 12 and further limits the claimed "generating means". As explained above, Eastwick cannot meet the limitations of claim 12 from which claim 13 depends. Therefore, Eastwick cannot have the further limitations of claim 13. The rejection of claim 13 is respectfully traversed.

Claim 14 depends from claim 13 and further limits the claimed "offering means". Because the Examiner realizes that Eastwick cannot meet this limitation, she refers to the rejection of claim 5 which irrelevantly states:

....whereas Eastwick's teachings of a software interface in conjunction with legacy data in a database reads on Applicant's claim language involving a BIS.

This finding is legally irrelevant, because it does not address Applicants' claimed invention. Furthermore, even if relevant, it is inadequate as a matter of law, because it does not show the "identical invention in as complete detail as is contained in the claim" as is explicitly required by MPEP 2131. The rejection of claim 14 is respectfully traversed.

Claim 15 depends from claim 14 and further limits the claimed "generating means". As explained above, Eastwick cannot meet the limitations of claim 14 from which claim 15 depends. Therefore, Eastwick cannot have the further limitations of claim 15. The rejection of claim 15 is respectfully traversed.

Claim 16 is an independent apparatus claim having a different statutory, judicial, and administrative standard of patentability from claim 11. Furthermore, claim 16 explicitly requires the claimed "stored procedure" to be located within the claimed legacy data base. Nevertheless, the Examiner states:

Thus, claim 16 is analyzed as previously discussed with respect to claim 11 above.

Therefore, claim 16 has been inadequately examined, both as a matter of fact (i.e., unique limitations) and as a matter of law (i.e., different basis for patentability). The rejection of claim 16, and all claims depending therefrom, is respectfully traversed for failure of the Examiner to examine the claim as required by controlling law.

Claim 17 depends from claim 16 and is further limited by "a plurality of variables loaded into said scripted command language stored procedure in response to said service request". Again, the Examiner cites operational details of workstation 102 having nothing to do with the claimed causing "said accessing step to add parameters to said stored procedure". The rejection of claim 17 is respectfully traversed for failure of Eastwick to meet the requirements of MPEP 2131 to show anticipation.

Claim 18 depends from claim 17 and is further limited by "a second service request generated by said user terminal causes said legacy data base management system to execute said scripted command language stored procedure". Again, the Examiner cites operational details of workstation 102 having nothing to do with the claimed causing "said legacy data base management system to add parameters to said stored procedure". The rejection of claim 18 is respectfully traversed for failure of Eastwick to meet the requirements of MPEP 2131 to show anticipation.

Claim 19 depends from claim 18 and further limits the claimed coupling network to the "Internet". In making her rejection, the Examiner clearly erroneously states:

As for Claim 8, Eastwick et al teaches a publicly accessible digital data communication network further comprises the Internet (col. 3, lines 65-67 - col. 4, lines 1-3).

This statement is clearly erroneous, because Eastwick makes no mention of a "publicly accessible" network as claimed and

certainly says nothing of the Internet. The rejection of claim 19 is respectfully traversed as based upon clearly erroneous findings of fact.

Claim 20 depends from claim 19 and further limits the claimed "data base management system". Because the Examiner realizes that Eastwick cannot meet this limitation, she irrelevantly states:

....whereas Eastwick's teachings of a software interface in conjunction with legacy data in a database reads on Applicant's claim language involving a BIS.

This finding is legally irrelevant, because it does not address Applicants' claimed invention. Furthermore, even if relevant, it is inadequate as a matter of law, because it does not show the "identical invention in as complete detail as is contained in the claim" as is explicitly required by MPEP 2131. The rejection of claim 20 is respectfully traversed.

Claim 21 is an independent apparatus claim having four unique claimed elements. These limitations are not found in claim 1. Nevertheless, the Examiner does not apply Eastwick to these limitations, because she could not. Therefore, the rejection of claim 21 is respectfully traversed for failure to be examined in addition to the failure of Eastwick to show anticipation as specified by MPEP 2131.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this

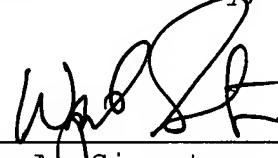
amendment and allowance of claims 1-21 being the only pending claims.

Please charge any deficiencies or credit any overpayment to Deposit Account No. 14-0620.

Respectfully submitted,

Tadd E. Vanyo et al.

By their attorney,



---

Wayne A. Sivertson  
Reg. No. 25,645  
Suite 401  
Broadway Place East  
3433 Broadway Street N.E.  
Minneapolis, MN 55413  
(612) 331-1464

Date June 29 2007